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Supreme Court of the United States

OCTOBER TERM, 1941

No. ~~1130~~ 71

UNITED CARBON COMPANY and
UNITED CARBON COMPANY, INC.,

Petitioners,

vs.

BINNEY & SMITH COMPANY,

Respondent.

REPLY BRIEF FOR RESPONDENT

DEAN S. EDMONDS,
Attorney for Respondent.

WILLIAM H. DAVIS,
ROGER T. MCLEAN,
Of Counsel.

Supreme Court of the United States

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No. 1130

UNITED CARBON COMPANY and
UNITED CARBON COMPANY, INC.,

Petitioners,

vs.

BINNEY & SMITH COMPANY,

Respondent.

REPLY BRIEF FOR RESPONDENT

Petitioners' reply brief states that during the further progress of the litigation of the patent here in suit "respondent can continue to exercise its monopolistic control of the carbon black industry and its incidental control of the tire and rubber industry by the patent in suit" (p. 3). So extravagant a statement with so little in the record to support it and so much to contradict it rarely appears in a brief of reputable counsel. There is no "monopolistic control" of the carbon black industry, nor could there be. And as for control of the rubber industry by the patent here in suit or any other patent relating to carbon black, that is impossible and the suggestion of it borders on the absurd.

We have pointed out that the record evidence is that the patent owner is ready and willing to grant licenses under the patent (R. p. 48). Two manufacturers of carbon black now hold license rights under the patent (R. pp. 48, 63-4). License rights have been offered to these Petitioners; the offer of license rights was made prior to this litigation and has been made since the decision of the Court of Appeals. The licenses already issued and that offered to these Petitioners contain no restriction as to price, quantity, use or territory, such as has been the subject of criticism in recent years.

Further as to the alleged monopolistic control of the carbon-black industry, in each year there are many millions of pounds of carbon-black made and sold in a form which does not involve use of the patented invention. Carbon-black is used extensively in printing inks, paints, lacquers, carbon paper, etc., and none, or at most very little, of the black so used is in the form covered by the patent in suit. Obviously, no control, monopolistic or otherwise, of that form of black could be exercised under the patent.

Further as to monopolistic control of the rubber industry, the record of this case makes it clear that carbon-black has been used in rubber manufacture continuously since about 1915, that its use assumed large proportions early in that period, and that carbon-black covered by the patent in suit did not come into use on any considerable scale until about 1933. Obviously the rubber manufacturing industry is free, so far as this patent is concerned, to make rubber articles with carbon-black in the form in which it was used from 1915 to 1933. No sacrifice of quality would be involved in this; the merits of the patented invention lie elsewhere than in the quality of the rubber product.

This obnoxious and unfounded statement of counsel for Petitioners, together with the statements in their main brief, carries the suggestion that the alleged "monopolistic control" constitutes a threat to the production of necessary munitions of war made wholly or partly of rubber. It seems much more likely that the production of such munitions will be subject to the control of the amount of rubber available. Rubber manufacture has already been greatly curtailed. It may be that the carbon-black which will be needed for rubber manufacture in the next year or two can be supplied by those who now have rights under the patent in suit or by them and such others as take licenses under the patent. If that is not so, still there is not the slightest ground for apprehension that rubber manufacture will be disturbed in the least by this patent. In this emergency the National Government can and does order from manufacturers such products and in such amounts as are determined by the Government's representatives and no patent owner can make use of his patent, assuming he had so reprehensible a desire, to check or restrict the operations of the manufacturer. That is taken care of adequately by the Act of July 1, 1918 (35 U. S. C., Sec. 68).

These being the facts, which cannot be outside the knowledge of Petitioners and their representatives, we cannot view these assertions of Petitioners in their brief as other than an appeal to a prejudice which they think or assume is existent, and an attempt to make use of false suggestion in an effort to secure a review by this Court in a fact situation where there is no basis for such review in the rules and procedure of this Court applicable to the grant of certiorari in suits for patent infringement.

Petitioner proceeds with the further charge that Respondent will use every means in its power to bring about

postponement of decisions in the suits now pending in the First and Third Circuits, Petitioner appearing to assume that the ultimate decisions of the Courts of Appeals in those cases will be adverse to the patent and thus produce the conflict of decision which would call for the grant of certiorari. We resent the suggestion that Respondent's counsel will resort to improper tactics having delay as their primary purpose; furthermore, the accused infringers in those other suits are not powerless to advance them to a speedy conclusion, nor do we think they would be unable to secure the cooperation of the Courts to that end if they solicited it and showed that they were entitled to it.

Respectfully submitted,

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ROGER T. MCLEAN,
Counsel for Respondent.

New York, N. Y., May 8, 1942.